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Appl. No. 094988-620
Docket No. 1422-0507P
Page

REMARKS

Status of the Claims

With the above amendments, claims 1-5 have been amended and claims 6-20 have been added. Claims 1-20 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Claims 1-4 have been amended simply for form. The amendment to claim 5 has support at page 13, lines 1-6. New claims 6-7 have support at page 13, lines 2-3. New claims 8-9 have support at page 3, line 21. New claims 10-11 have support at page 5, lines 10-13. New claims 12-18 have support at page 8, lines 8-13. New claims 19-20 have support at page 10, lines 1-3. Reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 USC §112, second paragraph and 35 USC §101

Claim 5 has been rejected under 35 USC §112, second paragraph and 35 USC §101 for reciting a "use" claim, which is not a statutorily recognized form of claims in the United States. Applicants have amended claim 5 so that it no longer recites a "use" claim. Withdrawal of the rejection is respectfully requested.

Rejections under 35 USC §102

Claims 1-5 are rejected under 35 USC §102(b) as being anticipated by Kakuda '866 (US Patent No. 5,501,866).

This rejection is traversed for the following reasons.

Disclosure of Kakuda '866

Kakuda '866 discloses a caffeine stimulation inhibitor by combining the use of theanine extracted from tea leaves and/or a substance having theanine for its major active ingredient. The inhibitor is produced by extracting tea leaves with a solvent such as water, hot water or ethanol, chemical synthesis, microbial fermentation or plant tissue culturing. The active ingredients are said to inhibit the stimulatory action of caffeine without degrading the quality, such as the flavor and aroma, of caffeine-containing beverages and foods, allowing persons hypersensitive to caffeine to consume caffeine-containing beverages and foods without worry over its effects.

The Examiner asserts that Kakuda '866 discloses a composition comprising theanine that can be used to suppress the effects of caffeine. Applicants point out that the instant claims are directed to a "sleep-promoting composition" as claimed in claim 1 and "a method for promoting sleep" as claimed in claim 4.

Applicants submit that Kakuda '866 is not an anticipatory reference as it does not disclose a "sleep-promoting composition" or "a method for promoting sleep" but only discloses a method of inhibiting the effects of caffeine. Kakuda '866 discloses that the caffeine stimulation inhibitor of its disclosure is useful for those people who are hypersensitive to caffeine and/or desire to suppress

the action of caffeine (including those who desire to drink tea and coffee without impairing sleep). See column 2, lines 59-62 in Kakuda '866. This is not a "sleep-promoting composition" or a "method for promoting sleep". The prevention of impairing sleep is not the same as a sleep-promoting composition. In other words, the effects of sleep-promoting are never taught or suggested by Kakuda '866.

Moreover, the effects of theanine as a sleep-promoting composition in the present invention can be exhibited whether or not caffeine is present. Examples 3 and 4 of the instant invention were performed with food and beverages that did not contain caffeine. Nevertheless, Examples 3 and 4 proved to be effective sleep-promoting compositions.

Accordingly, Kakuda '866 cannot anticipate the instant invention because it fails to teach the elements of the instantly claimed invention. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks and amendments, it is believed that the claims, as they now stand, define patentable subject matter such that a passage of the instant invention to allowance is warranted.

A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

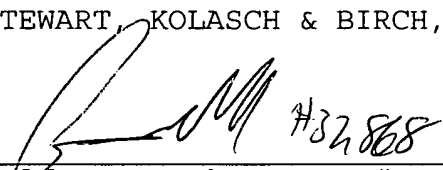
Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicant respectfully petitions for a one (1) month extension of time for filing a response in connection with the present application and the required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By


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Attachment: VERSION WITH MARKINGS TO SHOW CHANGES MADE



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims have been amended as follows.

1. (Amended) A sleep-promoting composition [for promoting sleep,] comprising theanine.
2. (Amended) Food comprising the composition of claim 1 [for an individual having sleep disorders].
3. (Amended) A medicament comprising the composition of claim 1 [for an individual having sleep disorders].
4. (Amended) A method for promoting sleep in an individual having sleep disorders, comprising administering an effective sleep promoting amount of theanine to the individual having sleep disorders.
5. (Amended) A method of promoting sleep comprising administering to a patient suffering from a sleep disorder a composition comprising sugar, L-theanine, flavor and tartaric acid [Use of theanine for preparation of food or medicament for an individual having sleep disorders].

Claims 6-20 have been added.